

REMARKS

Reconsideration and further examination of the subject patent application in light of the present Amendment and Remarks is respectfully requested. Claims 1-58 are currently pending in the application. Claims 1-58 stand rejected.

Response to General Comments

With regard to claims 4 and 32, the Office Action asserts that “even if advertiser may indicate that his ads may be printed in a physical ad-book, the system is operable, however, to disable this function, especially since the advertisements are primarily viewed on line or over the Internet” (Office Action of 6/25/08, paragraph bridging page 2-3). However, a review of the specification fails to provide any support for the Examiner’s statements. For example, the statement that “ad-books may not be printed in physical form” (specification, page 10, lines 14-15) merely indicates that that the ad-books may or may not be printed, when advertisements are viewed from user terminals. Nowhere within the specification is there any support for the assertion that “the system is operable . . . to disable this feature.” Since there is no support for this assertion, the assertion by the Office Action is not well founded.

There is also no basis for the assertion that “the advertisements are primarily viewed on line or over the Internet.” In fact, a word search of the specification reveals that the word “view” is used 9 times and the word “print” is used 19 times. As such, the specification offers objective evidence that an ad-book would more likely be printed than viewed on line or over the Internet.

The Office Action goes on to assert that “using the ‘ad book’, having inserted therein ads placed by advertisers or supporters, as a vehicle to raise funds on behalf of charities is a non-functional descriptive material that does not impact the content of the ads per se and the manner in which the ads are created and placed into the ‘ad book’. The same ‘ad book’ could be used to raise money for any other project. In other words, the purpose or the specific use of the ‘ad book’, having ads inserted therein, does not immediately impact the functionality of the system” (Office Action of 6/25/08, page 3). The flaw in the assertion, however, is that an “ad-book” and especially an “ad-book” for a charitable organization is physically different than any other kind of book in general. Ad books are created for the very special purpose of honoring the not-for-profit organization and its contributors. As such, the claimed context “where the ad-book or related print publication is a fundraising vehicle and the governmentally recognized not-for-profit organizations, members or supporters of the organization solicit for or place the ads or messages to make contributions to the organization” is structural because it defines the subject matter of the claimed system.

Claims Objections

Claims 1, 28, 29 and 50 have been objected to. In particular, the Office Action asserts that “Regarding claims 1, 29 and 50, ‘and wherein at least some of the ‘ads’ or ‘messages’ should apparently be - - wherein the ad or message” (Office Action of 6/25/08, page 3). However, there is no requirement within the specification that each “ad” or “message” within an ad-book contain a laudatory statement. As such, the objection is improper and should be withdrawn.

The Office Action asserts that “Throughout the claimed invention, ‘ad’, ‘ad-book’ should apparently be - - ad - -, - - ad-book - - .” In response, the suggested changes have been implemented.

Rejections Under 35 U.S.C. §112

Claims 1, 28, 29 and 50 stand rejected under 35 U.S.C. §112, second paragraph. In particular, the Office Action asserts that “It is unclear what the metes and bounds of ‘legally defined’ are” (Office Action of 6/25/08, page 3). In response, the words “legally defined” have been replaced by “governmentally approved.” It should be noted that the term “not-for-profit” would be understood by those of skill in the art to have meaning only in the context of governmental tax codes and in the context of the tax issues discussed in the last full paragraph of page 9 of the Specification. As such, “governmentally approved not-for-profit organizations” would be understood to be organizations that meet the well-defined criteria required by those tax codes.

Rejection Under 35 U.S.C. §103

Claims 1-9, 12-15, 16-27, 40-49 and 50-58 stand rejected under 35 U.S.C. §103(a) as being obvious over U.S. Pat. Publ. No. US 2002/0188532 to Rothstein. Applicant respectfully traverses these rejections.

In response, independent claim 1 has been further limited to “receiving a pledge or contribution from the member, supporter or contributor on behalf of the governmentally recognized not-for-profit organization.” Independent claims 28, 29 and 50 have been similarly limited. The acceptance of payments for ads within an ad-book is

discussed in the last full paragraph of page 9 of the Specification. As would be clear to those of skill in the art, the acceptance of payment for an ad in an ad-book would also necessarily involve acceptance of a contribution on behalf of the non-for-profit organization.

Claims 1-9, 12-15, 16-27, 40-49 and 50-58 are now clearly differentiated over Rotherstein on any of a number of different levels. On a first level, Rothstein is merely directed to commercial advertising in electronic books. Nowhere within Rothstein is there any teaching or suggestion of any system that accepts contributions on behalf of governmentally approved not-for-profit organization.

On another level, independent claim 1 is also limited to the context “wherein at least some of the “ads” or messages in the “ad-book” or related print publication contain laudatory statements about the legally defined not-for-profit organization, its activities or its members.” Independent claims 28, 29 and 50 are similarly limited.

In contrast, Rothstein is directed to commercial advertising and fails to provide any teaching or suggestion of the use of laudatory statements regarding not-for-profit organizations. Moreover, “Differences between an invention and the prior art cited against it cannot be ignored merely because those differences reside in the content of the printed matter . . . the board cannot dissect a claim, excise the printed matter from it, and declare the remaining portion of the mutilated claim to be unpatentable” In re Gulak (217 USPQ 403).

Moreover, the claimed laudatory statements are functionally related to the process and apparatus for creating “ad-books.” For example, it has been found that the liberal use of laudatory statements and/or images in “ads” of “ad-books” (limited only by the

contributor's imagination) encourages greater generosity in contributions from other contributors to the non-for-profit organization. As such, laudatory statements are functionally related to the process of publishing "ads" in "ad-books" by not-for-profit organizations.

Moreover, "the burden of establishing the absence of a novel, non-obvious functional relationship rests with the PTO" (In re Lowry, 32 USPQ2d 1035). Since the laudatory statements are functionally related to the publication of "ad-books", the laudatory statements are entitled to be patentable weight.

Moreover, the Office Actions have failed to demonstrate the existence of any relevant art directed to the not-for-profit sector. In each case, the references cited in the Office Actions have been directed to commercial endeavors, not to not-for-profit organizations. Since the claims are directed to not-for-profit organizations, the claims are clearly differentiated over the cited art.

The Office Action admits that "Rothstein does not expressly disclose that the contributor or advertiser uses a preparation tool or software stored on a server to craft or create an ad that is to be inserted in the ad book and that the organization (publisher) uses the "ad book, having inserted therein one or more ads placed by advertisers or supporters, as a fund raising vehicle", but goes on to assert that "it is common practice in the art for an organization or a third party (merchant or a clearinghouse) to raise funds on behalf of a non-profit or charitable organization using a plurality of well-known methods (see the Burke's Patent cited in the conclusion section)" (Office Action of 6/25/08, page 6). However, Burke appears to be merely directed to a point of sale (POS) system for

collecting funds for investments or donations. As such, the references to common practice amounts to nothing more than conjecture of what might be or could be.

The Office Action asserts that “using the ‘ad book’, having inserted therein ads placed by advertisers or supporters, as a vehicle to raise funds on behalf of charities is an ‘intended use’ recitation” (Office Action of 6/25/08, page 8). However, rather than being a statement of intended use, the limitations are, instead, an affirmative statement defining the “receiving a contribution” step.

The Office Action asserts that “it would have been obvious . . . using or implementing the system of Rothstein . . . to incorporate the above disclosure (‘Official Notice’) into the system of Rothstein so as to use the ‘electronic book’ or ‘ad book’ or publication as a vehicle to raise money or funds . . . on behalf of a charity or non-profit organizations” (Office Action of 6/25/08, page 8). However, as noted in previous Responses, this Office Action and previous Office Actions provide no basis for any belief that Rothstein in view of any supposed common knowledge in the art would render the claimed invention obvious. Accordingly, it is respectfully requested that specific references be provided in support of the Official Notice as required by MPEP §2144.03(C).

Claims 10, 11, 38 and 39 stand rejected under 35 U.S.C. §103(a) as being obvious over Rothstein. Applicant respectfully traverses the rejections.

The Office Action admits that “Rothstein does not explicitly disclose that the web server comprises a firewall for maintaining security”, but goes on to assert that “it is common practice in the art of computer technology to use or install a firewall module” (Office Action of 6/25/08, page 10). The Office Action further asserts that “it would

have been obvious to an ordinary skill artisan, using or implementing the system of Rothstein . . . to incorporate the above disclosure ('Official Notice') into the system of Rothstein so as to install a firewall module" (Office Action of 6/25/08, page 10). However, the Office Action provides no basis for any assertion that it would be obvious to use a firewall on a website used for charitable contributions and it is believed that none exist. Accordingly, it is respectfully requested that specific references be provided regarding the use of firewalls in the context of a website used for selling ad for charitable organizations in support of the Official Notice and as required by MPEP §2144.03(C).

For any of the above reasons, Rothstein fails to teach or suggest each and every claim limitation. Since Rothstein fails to teach or suggest each and every claim limitation, the rejections are improper and should be withdrawn.

Affidavit Under 37 CFR §1.131

Attached to this Response is an Affidavit under 37 CFR §1.131 establishing invention of the claimed subject matter by Mr. Bruce A. Fogelson by at least February 2000. Since Rothstein was not filed until March 10, 2000, Rothstein is no longer prior art to the claimed invention. Since Rothstein is no longer prior art, the rejections under Rothstein are now improper and should be withdrawn.

Closing Remarks

Allowance of claims 1-58, as now presented, is believed to be in order and such action is earnestly solicited. Should the Examiner be of the opinion that a telephone conference would expedite prosecution of the subject application, he is respectfully

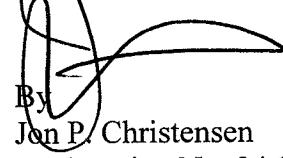
Serial No.: 09/885,970

PTO Office Action dated: June 25, 2008

requested to telephone applicant's undersigned attorney.

The Commissioner is hereby authorized to charge any additional fee which may be required for this application under 37 C.F.R. §§ 1.16-1.18, including but not limited to the issue fee, or credit any overpayment, to Deposit Account No. 23-0920. Should no proper amount be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal, or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 23-0920.

Respectfully submitted,
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